

S/N 09/599,808

Response to Office Action Dated 12/02/2004

REMARKS

Claims 1-17 and 81-82 are currently pending. Of these claims: claims 3-4, 6-13 and 17 are original; claim 5, was previously presented; claims 1, 2, 14-16 and 81-82 are currently amended; claims 18-80 were previously withdrawn; and, no claims are currently cancelled. In view of the following remarks, the Applicant respectfully requests reconsideration and withdrawal of the rejections and forwarding of the application on to issuance.

35 U.S.C. §102 Rejections

Claims 1, 3-8 and 11-17 were rejected under §102 as being anticipated by U.S. Patent No. 5,630,126, hereinafter "Redpath." In response, the Applicant respectfully traverses the rejection.

Applicant submits that the Office has failed to establish a *prima facie* case of anticipation and respectfully traverses the Office's rejections. However, before discussing the substance of the Office's rejections, a section entitled "The §102 Standard" is provided and will be used in addressing the Office's rejections. Following this section, a section entitled "The Redpath Reference" is provided, which describes Redpath's disclosure and teachings.

The §102 Standard

According to the MPEP §2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 Anticipation is a legal term of art. The applicant notes that in order to
2 provide a valid finding of anticipation, several conditions must be met: (i) the
3 reference must include every element of the claim within the four corners of the
4 reference (see MPEP §2121); (ii) the elements must be set forth as they are recited
5 in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be
6 modified (see MPEP §706.02, stating that "No question of obviousness is present"
7 in conjunction with anticipation); and (iv) the reference must enable the invention
8 as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions
9 must be simultaneously satisfied.

10 The §102 rejection of claims 1, 3-8 and 11-17 is believed to be in error.
11 Specifically, the PTO and Federal Circuit provide that §102 anticipation
12 requires that each and every element of the claimed invention be disclosed
13 in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655
14 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited
15 §102 reference of any claimed element negates the anticipation. *Kloster*
16 *Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81
17 (Fed. Cir. 1986).

18 The applicant notes the requirements of MPEP §2131, which states
19 "to anticipate a claim, the reference must teach every element of the claim."
20 This MPEP section further states that "'A claim is anticipated only if each
21 and every element as set forth in the claim is found, either expressly or
22 inherently described, in a single prior art reference.' *Verdegaal Bros. v.*
23 *Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053
24 (Fed. Cir. 1987). 'The identical invention must be shown in as complete
25

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868
2 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements
3 must be arranged as required by the claim, but this is not an ipsissimis verbis
4 test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831,
5 15 USPQ2d 1566 (Fed. Cir. 1990)." 6

7 **The Redpath Reference**

8 Redpath discloses integrating computations into compound
9 documents (Redpath, at Title). Redpath discloses compound documents
10 having a text part and a plurality of math parts positioned in a plurality of
11 locations. (Redpath, at Abstract.) Redpath teaches linking a plurality of
12 math parts located within a document together so that related math parts are
13 evaluated and updated upon user input. (Summary of the Invention, col. 2,
14 lines 38-40.) 15

16 **Traversal of the §102 Rejections**

17 Claims 1, 3-8 and 11-17 were rejected under §102 as being anticipated by
18 U.S. Patent No. 5,630,126, hereinafter "Redpath." In response, the Applicant
19 respectfully traverses the rejection. 20
21
22
23
24
25

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 **Claim 1, as amended, recites a method comprising:**

- 2 • presenting a free floating field in line with text in a document, the
3 free floating field presenting content derived from a source;
4 • determining, **upon selection of the free floating field**, a type of
5 content in the free floating field;
6 • interpreting user entry based upon the type of content in the free
7 floating field; and
8 • upon modification of the source, automatically updating the content
9 in the free floating field.

10 Claim 1 has been amended to incorporate elements recited in claim 14, and
11 claim 14 has been amended to incorporate elements recited in claim 1. Claim 14
12 continues to depend from claim 1. Both claims currently stand as rejected under
13 section 102(b) as being anticipated by Redpath. Accordingly, the section 102(b)
14 rejection of claim 14 is addressed with respect to claim 1.

15 Column 6, lines 15—18 of the Redpath reference were cited in the
16 rejection. The cited passage in Redpath is as follows:

17 “The evaluating operation 200 accepts user input in the form of
18 either numeric or non-numeric strings, and either evaluates a formula
19 contained within a first math part or assigns the value given to the math
20 part.”

21 Redpath does not disclose a process by which the type of content within a
22 field is determined upon selection of the free-floating field. The passage in
23 Redpath indicates that Redpath will accept user input in the form of either numeric
24 or non-numeric strings, and then evaluate those strings to determine if they are
25 non-numeric strings (see box 202, Fig. 4) or numeric strings (see box 204, Fig. 4).
This evaluation is performed after entry of the data, and not *upon selection* of the
free-floating field.

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 Referring in particular to Fig. 4 of Redpath (see associated text at column 7,
2 lines 33-47), Redpath discloses (1) receiving input; (2) checking the received input
3 to determine its type; and then (3) treating that input according to its type. Thus,
4 Redpath determines a type of content upon examination of the input, not upon
5 selection of the free-floating field.

6 In contrast, the Applicant's claim recites determination of the content type
7 upon selection of the field, which can be before the entry (data string) has been
8 entered. This affords the Applicant with several advantages, some of which are
9 discussed within the paragraph at the top of page 30 of the Applicant's disclosure.

10 The Patent Office suggests that lines 15-18 of column 6 disclose the
11 elements recited by the amended claim 1. However, this passage reveals that
12 Redpath determines a type of content upon examination of the input, not upon
13 selection of the free-floating field. Redpath teaches that the input is evaluated to
14 determine its type after receipt of that input (see Fig. 4). Thus, Redpath does not
15 determine, upon selection of the field, a type of content.

16 Because Redpath does not disclose the elements recited by claim 1,
17 Redpath does not accrue the associated advantages. Accordingly, the Applicant
18 respectfully requests that the rejection be removed, and that claim 1 be allowed to
19 issue.

20 **Claims 3-8 and 11-12** depend from Claim 1 and are allowable due to their
21 dependence from an allowable base claim. These claims are also allowable for
22 their own recited features that, in combination with those recited in Claim 1, are
23 neither disclosed nor suggested in references of record, either singly or in
24 combination with one another.

25

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 **Claim 13 was not rejected by any statement in the Office Action, and the**
2 **Applicant respectfully requests that this claim be allowed.**

3 **Claim 14 recites the method of claim 1, additionally comprising:**

- 4 • wherein the free floating field and the source are in a nested
5 relationship.

6 Claim 14 has been amended to incorporate elements recited in claim 1, and
7 claim 1 has been amended to incorporate elements recited in claim 14. Claim 14
8 continues to depend from claim 1. Both claims currently stand as rejected under
9 section 102(b) as being anticipated by Redpath.

10 Claim 14 depends from Claim 1 and is allowable due to its dependence
11 from an allowable base claim. This claim is also allowable for its own recited
12 features that, in combination with those recited in Claim 1, are neither disclosed
13 nor suggested in references of record, either singly or in combination with one
14 another.

15 Claim 14 is additionally allowable because claim 14 recites what was
16 paragraph 3 in claim 1, prior to amendment. *This material was not specifically*
17 *rejected by the Patent Office.* Accordingly, claim 14 is in condition for allowance.

18 Claim 14 is additionally allowable because the references of record,
19 Redpath and Acklen, do not disclose the elements recited by claim 14. The
20 Applicant notes that the Redpath reference does not disclose nested relationships
21 generally, much less the nested relationship recited in claim 14. This position is
22 supported by statements made by the Patent Office in the middle portion of page 8
23 of the document mailed 12/02/2004, in the discussion of claims 81 and 82.

24 Additionally, the Applicant notes that the Acklen reference does not
25 disclose the nested relationship recited in claim 14. In particular, page 254 of

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 Acklen was recited (with respect to claims 81 and 82) for its disclosure that a table
2 could be created at any desired ‘insertion point,’ and that a new table could be
3 created inside any text box. However, page 254 of Acklen fails to disclose a free-
4 floating field and source in a nested relationship. In fact, the field and source
5 relationship (wherein the source is used to update the contents of the field) is
6 *completely undisclosed* by page 254 of Acklen.

7 In addition, page 429 of Acklen was cited because a floating cell is nested
8 inside a table (Fig. 15.28). In particular, a free-floating field containing the value
9 “7%” is nested within the table. This free-floating field, containing the value 7%,
10 is “the source,” in that the 7% value is used, as the source, to deflate the list price
11 of \$12.99 to the discount price of \$12.08. (See page 429 of Acklen.) Thus,
12 Acklen does not disclose a “free floating field and the source are in a nested
13 relationship,” since in Acklen, the free-floating field and the source are one in the
14 same.

15 Accordingly, because Redpath and Acklen do not disclose such nested
16 relationships wherein the source is used to update the free-floating field, and
17 because the Patent Office does not suggest that Redpath does discloses nesting the
18 free-floating field and the source, the Redpath and Acklen references are deficient
19 in their disclosure of the elements recited by claim 1. Accordingly, the Applicant
20 respectfully requests that the rejection should be removed, and that claim 1 be
21 allowed to issue.

22 **Claim 15** recites, wherein the determining comprises:

- 23
- 24 • evaluating whether the type of content is a formula or non-text data;
 - 25 • if the type of content is a formula or non-text data, interpreting the user entry as applicable to spreadsheet functions; and

S/N 09/599,808

Response to Office Action Dated 12/02/2004

- 1 • if the type of content is not a formula or non-text data, interpreting
2 the user entry as applicable to word processing functions.

2 In the rejection of claim 15, the Patent Office cited column 6, lines 15-18 of
3 Redpath as disclosing the elements of all three paragraphs of claim 15. The
4 Applicant respectfully traverses the rejection.

5 The cited passage in Redpath is as follows:

6
7 “The evaluating operation 200 accepts user input in the form of
8 either numeric or non-numeric strings, and either evaluates a formula
9 contained within a first math part or assigns the value given to the math
10 part.”

10 The Applicant notes that the passage does not disclose elements recited by
11 the Applicant's claim. In particular, the cited passage in Redpath does not
12 disclose both (1) spreadsheet functions, and also (2) word processing functions.
13 Instead, Redpath mentions one or more math parts. The one or more math parts
14 do not disclose *both* the spreadsheet functions and word processing functions
15 recited by the claim. Thus, cited passage in Redpath fails to disclose the structures
16 recited in the claim, or even to disclose a similar number of analogous structures.

17 Therefore, the elements recited by claim 15 are not shown by the passage
18 cited in Redpath. Accordingly, the Applicant respectfully requests that the
19 rejection to claim 15 be withdrawn.

20 **Claims 16 and 17 depend from Claim 1 and are allowable as depending**
21 from an allowable base claim. These claims are also allowable for their own
22 recited features that, in combination with those recited in Claim 1, are neither
23 disclosed nor suggested in references of record, either singly or in combination
24 with one another.

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 The §103 Rejections

2 Claims 2, 81 and 82 stand rejected under 35 U.S.C. §103(a) as being
3 obvious over Redpath in view of "Using Corel Wordperfect 9," hereinafter
4 "Acklen."

5 The Applicant submits that the Office has failed to establish a *prima facie*
6 case of obviousness and, in view of the comments below, respectfully traverses the
7 Office's rejections. However, before discussing the substance of the Office's
8 rejections, a section entitled "The §103 Standard" is provided and will be used in
9 addressing the Office's rejections. Following this section, a section entitled "The
10 Acklen Reference" is provided, which describes Acklen's disclosure and
11 teachings.

13 The §103 Standard

14 To establish a *prima facie* case of obviousness, three basic criteria *must* be
15 met. First, there must be some suggestion or motivation, either in the references
16 themselves or in the knowledge generally available to one of ordinary skill in the
17 art, to modify the reference or to combine reference teachings. *In re Jones*, 958
18 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5
19 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation
20 of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.
21 1986). Finally, the prior art reference (or references when combined) must teach
22 or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580
23 (CCPA 1974).

1 Hence, when patentability turns on the question of obviousness, the search
2 for and analysis of the prior art includes evidence relevant to the finding of
3 whether there is a teaching, motivation, or suggestion to select and combine or
4 modify the references relied on as evidence of obviousness. The need for
5 specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55
6 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the
7 reason the skilled artisan, with no knowledge of the claimed invention, would have
8 selected these components for combination in the manner claimed").

9

10 The Acklen Reference

11 The Acklen reference describes aspects of the user interface for
12 WordPerfect 9. Acklen describes the creation and modification of tables for
13 HTML applications, such as web pages. (Page 583.) Acklen also discloses the
14 use of "Floating Cells." (Page 429.) Floating cells are a method of working with
15 spreadsheet data. In particular, floating cells are invisible cells that display their
16 contents as if they are part of the text that surrounds them. (Id.) Thus, floating
17 cells look like other text, and can be positioned by an insertion point were the
18 floating cell is desired. (Id.)

19

20 Traversal of the §103 Rejections

21 Claims 2, 81 and 82 depend from Claim 1 and are allowable as depending
22 from an allowable base claim. These claims are also allowable for their own
23 recited features that, in combination with those recited in Claim 1, are neither

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 disclosed nor suggested in references of record, either singly or in combination
2 with one another.

3 **Claims 9 and 10** stand rejected under 35 U.S.C. §103(a) as being
4 unpatentable over Redpath in view of "Microsoft Visual Basic 5.0 Programmer's
5 Guide, 1997, pgs. 578—579, Redmond, Washington, 98052-6399" hereinafter
6 "Microsoft."

7 **Claim 9** recites the method of claim 8, further comprising:

- 8 • resizing the formula edit box as the user enters the formula.

9 **Claim 10** recites the method of claim 8, further comprising:

- 10 • extending the formula edit box horizontally and subsequently
vertically as the user enters the formula.

11 The Microsoft reference discloses how a picture box can be sized to fit a
12 picture to be displayed. However, sizing a box to fit a picture fails to address and
13 resolve issues and complexities related to sizing a box as a user enters a formula,
14 particularly wherein the formula has an unknown length. For example, a picture
15 has a size, which when discovered, can be matched with a picture box of
16 appropriate size. In contrast, a text box may receive a user-entered formula of
17 unknown and/or changing size; accordingly, the recited features "resizing" and
18 "extending" provide functionality not seen in the references that address problems
19 associated with receiving a formula of unknown size.

20 In particular, the Microsoft reference fails to disclose how a box can be
21 resized *as a user enters a formula*, or how a box can be extended horizontally and
22 vertically *as a user enters a formula*. Entry of text into a box is different from
23 entry of a picture, since any given picture is fixed in size. In contrast, entry of a
24 formula is something that changes dynamically as each keystroke enters an
25 additional character. Thus, a formula edit box that resizes as the user enters a

S/N 09/599,808

Response to Office Action Dated 12/02/2004

1 formula is differently adapted than an edit box that is sized to fit a picture to be
2 displayed.

3 Accordingly, the Microsoft reference does not disclose the elements recited
4 by the claims, and the Applicant respectfully requests that the rejections be
5 removed and claim 9 and 10 be allowed to issue.

6 **Conclusion**

7 The Applicant submits that all of the claims are in condition for allowance
8 and respectfully requests that a Notice of Allowability be issued. If the Office's
9 next anticipated action is not the issuance of a Notice of Allowability, the
10 Applicant respectfully requests that the undersigned attorney be contacted for
11 scheduling an interview.

12 In particular, because no rejection was made to claim 13, claim 13 is in
13 allowable condition.

14 In the event that the Examiner finds any remaining impediment to a prompt
15 allowance of this application that could be clarified over the telephone, the
16 Examiner is respectfully requested to call the undersigned attorney.

17 Respectfully Submitted,

18 Dated: 4-4-05

19 By:

20 David S. Thompson
Reg. No. 37,954
Attorney for Applicant

21 LEE & HAYES PLLC
Suite 500
421 W. Riverside Avenue
Spokane, Washington 99201
Telephone: 509-324-9256 x235
Facsimile: (509) 323-8979